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09/651,130	08/30/2000	Kent Malmgren	010315-092	1064

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EXAMINER

ROCHE, LEANNA M

ART UNIT PAPER NUMBER

1771

DATE MAILED: 07/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MFE

**Office Action Summary**

Application No.

09/651,130

Applicant(s)

MALMGREN ET AL.

Examiner

Leanna Roche

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 2,4 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Sweden on August 30, 1999. It is noted, however, that applicant has not filed a certified copy of the 9903071-0 application as required by 35 U.S.C. 119(b).

### ***Specification***

2. The use of the trademarks has been noted in this application on pages 6, 11, 12 and 13 (TRITON, ALDRICH, CEKOL, CELPOL, BEROL, BEROCELL). Trademarks should be capitalized wherever they appear and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

3. The disclosure is objected to because of the following informalities: on page 6 of the specification, in the fourth line of the second full paragraph, "holder 3" should be changed to "holder 13". Appropriate correction is required.

### ***Claim Objections***

4. Claim 2 is objected to because of the following informality: line 3 of Claim 2 makes reference to the term "absorption capacity". It is believed by the examiner that Applicant intends to refer to the "absorption rate" disclosed in Claim 1. Appropriate correction is required.

5. Claims 4 and 6 are objected to because of the following informalities: the language of claims 4 and 6 appears to be a literal translation into English from a foreign document and is replete with grammatical and idiomatic errors. The examiner suggests amending claim 4 to read:

A liquid absorbent foam material as claimed in Claim 1, characterized in that the foam material contains fibers in its pore system.

The examiner suggests amending claim 6 to read:

An absorbent structure as claimed in claim 5, characterized in that said absorbent structure is comprised solely of said foam material.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims merely setting forth physical characteristics desired in an article, and not setting forth specific compositions which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in the future and which would impart the desired characteristics. Thus, the expression "a liquid

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absorbent open-cell foam material having...an absorption rate at wetting of at least 0.4 ml/s...a liquid distribution capacity at an inclination of 30° of at least 15 g/g and a liquid storage capacity of at least 9% ..." is too broad and indefinite since it purports to cover every open cell foam which will perform the desired functions regardless of its compositions, and in effect, recites compounds by what is desired that they do rather than what they are. The expression is also too broad since it appears to read upon materials that could not possibly be used to accomplish the purposes intended. See *Ex Parte Slob* (PO Bd App) 157 USPQ 172.

9. Claims 1 and 5 are indefinite because of the use of the term "etc." whose meaning inherently teaches indefiniteness.

10. Claim 3 recites the limitation "the gel liquid absorption" in line 3 of claim 3. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 3 recites the limitation "the capillary liquid absorption" in line 5 of claim 3. There is insufficient antecedent basis for this limitation in the claim.

12. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the

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remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 3 recites the broad recitation "the gel liquid absorption...is at least 4 g/g", and the claim also recites "preferably at least 5 g/g" which is the narrower statement of the range/limitation.

13. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 3 recites the broad recitation "the capillary liquid absorption...is at least 8 ml/g", and the claim also recites "preferably at least 10 ml/g" which is the narrower statement of the range/limitation.

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-7 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chen et al. (USPN 6261679).

Chen discloses an open-cell fibrous absorbent structure for use as absorbent articles such as feminine care pads, diapers, incontinence articles, bed pads and bandages for the intake, distribution, and retention of human body fluids. The open-cell

fibrous absorbent structure of Chen may be comprised of a polysaccharide such as carboxymethylcellulose and hydrophilic fibers such as chemically modified cellulosic fibers. Chen also discloses the use of surfactants and cross-linking agents to aid in the formation of their open-cell fibrous absorbent structure. The open-cell fibrous absorbent structure of Chen may be the sole component of an absorbent structure, and since open-cell fibrous absorbent structure of Chen may be used as a diaper, the open-cell fibrous absorbent structure of Chen may have a three-dimensional anatomic shape.

Because Applicant's claims are directed to physical characteristics desired in an article rather than setting forth specific compositions that would meet such characteristic, the examiner was directed to Applicant's specification to determine the scope of Applicant's claim. While Chen does not specifically disclose values for the absorption rate, liquid distribution capacity and liquid storage capacity, it appears that the open-cell fibrous absorbent structure of Chen is substantially identical to the presently claimed liquid absorbent open-cell polymeric foam material because both absorbent materials are made of substantially the same materials using substantially the same method. Thus, it is believed by the examiner that the open-cell fibrous absorbent structure of Chen inherently possesses an absorption rate, liquid distribution capacity and liquid storage capacity within Applicant's presently claimed ranges. Additionally, the presently claimed absorption rate, liquid distribution capacity and liquid storage capacity would have obviously been present once the open-cell fibrous absorbent structure of Chen was provided. See *In re Best*, 195 USPQ 433 footnote 4



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(CCPA 1977) as to the providing or this rejection under 35 USC 102 as well as 35 USC 103.

### ***Conclusion***

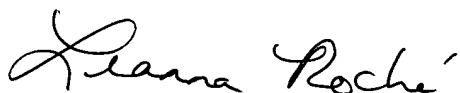
17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Qin et al. (USPN 5550189) discloses reacting carboxyalkyl cellulose compositions in an alkaline environment.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leanna Roche whose telephone number is 703-308-6549. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm (with alternate Mondays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



lmr  
June 25, 2002



ELIZABETH M. COLE  
PRIMARY EXAMINER